

Rejection of Claims 1, 5-12 and 15 under 35 U.S.C. § 103(a)

Claims 1, 5-12 and 15 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Japanese Patent Application No. JP 07-168293 to Kudo et al. (“Kudo”).

Applicants respectfully traverse these rejections for the following reasons.

Generally, in order to rely upon a reference under 35 U.S.C. § 103, the reference must be analogous prior art. Particularly, to determine the analogy of the field of endeavors, the particular problem with which the invention was concerned (In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) and the USPTO’s classification can be considered. MPEP 2141.01(a).

The subject matter of Kudo is distinct from that of the present invention. Kudo relates to a silver halide photosensitive material, while the present invention relates to an ink jet recording medium.

There is also an essential functional difference between the photosensitive material of Kudo and the ink jet recording medium of the present invention. The former functions by means of photosensitive effects, while the latter does not.

Kudo describes problems to be solved by the invention as follows: it was almost impossible to obtain high stability of magnetic I/O with the use of a ultra small amount of magnetic powders and high dispersability to attain transparency of the level required to be suitable for photosensitive materials, to prevent endurance deterioration attributed to frictions and abrasions of the magnetic head, to prevent the isolation of magnetic powers of metal oxide microparticles which is caused by a developing liquid, and the like. *See*, [0014]. The problems

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to be solved by the present invention are image blurring and lack of excellent light fastness for a long period of time. *See*, second full paragraph of page 4.

The photosensitive material of Kudo is classified under a different technical field from the ink-jet recording medium of the present invention. The silver halide photosensitive material (Kudo's invention) is classified into International Class G03C, while the ink jet recording medium of the instant application is classified into B32B, as shown in its US Application Publication No. 20040166252. The class G03C is defined as photosensitive materials for photographic purposes; photographic processes, e.g. cine, x-ray, colour, stereo-photographic processes; auxiliary processes in photography. The class B32B is defined as layered products, i.e. products built-up of strata of flat or non-flat, e.g. cellular or honeycomb, form. The difference in the class, although not dispositive, may be some evidence of "nonanalogy" of the filed of endeavors.

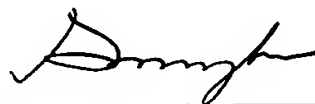
Therefore, Kudo is not analogous in the field of endeavors of the applicants of the present application and it is not appropriate to rely upon Kudo to reject the present application under 35 U.S.C. § 103. Accordingly, it is respectfully requested that the rejection be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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